

REMARKS

This is a request to reopen prosecution pursuant to 37 CFR 41.39(b) in response to the Examiner's Answer to the Appeal Brief filed for the instant application. As will be discussed further below, the Examiner raised at least one new ground of rejection in view of Applicants arguments presented in the Appeal Brief.

I. Allowable Subject Matter

The Final Action stated under "Allowable Subject Matter" that Claim 38 was objected to based on its dependence from rejected Claim 37. Claim 38 has been amended into independent form generally incorporating the subject matter of Claim 34 and 36. Applicants submit that Claim 38 is in condition for allowance.

II. Other Claim Amendments

Applicants have cancelled Claim 1 and written Claim 2 in independent form. Applicants have also written Claims 15 and 22 in independent form and cancelled Claim 14. Applicants have amended Claim 23 to incorporate the recitations of Claim 25 and have cancelled Claim 25. Claim 34 has also been amended to write Claim 34 in independent form. Claim 33 has been cancelled. Amendments to the dependent claims have also been made to correct dependencies in light of the cancellation of claims. Applicants submit that these amendments raise no new issues of patentability.

III. Interview Summary

The prior After Final Amendment is alleged to not have been received by the USPTO and hence was not entered by the Examiner. Hence, Applicants, out of an abundance of caution, provide the Interview Summary first stated in the After Final Amendment that was not entered. Applicants appreciate the courtesy extended to Applicants' representative, Timothy O'Sullivan, in the interview on April 26, 2004 with Examiners Matthew Smithers and Christopher Brown. In the Interview, the anticipation rejections were discussed and the legal standards regarding inherency. The applicability of inherency was discussed with respect to each of the references. Potential claim

amendments to write dependent claims in independent form were also discussed. No agreement was reached as to a specific claim amendment that would place the application in condition for allowance.

IV. The Section 102 Rejections

The Claims Are Patentable Over Chang

Claims 1-7, 9-12, 23-28 and 30-32 stand rejected under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 5,828,034 to Chang (hereinafter "Chang"). Applicants have cancelled Claim 1, written Claim 2 in independent form and amended Claim 23 to incorporate the recitations of Claim 25. Thus, Applicants will address the rejections of Claims 2 and 25. The Examiner's Answer rejects these claims based on col. 1, lines 57-64 and col. 6, lines 6-13 of Chang.

Under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted) (emphasis added).

A finding of anticipation further requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Thus, anticipation requires that a single prior art reference disclose each and every element of the anticipated claim.

The cited portion of Chang states in its entirety:

Control box 76 includes a conventional manual rheostat switch 77 which a user can turn the heating elements 18, 38, 54 & 64 on or off and to set and adjust relative temperatures of the warmed input device 10, 30, 51, and/or 61. Alternatively, the control box 76 could included several manual switches 78 in addition to an on-off switch 77 for establishing temperature set points which are then read by conventional microprocessor circuitry to control the degree of warmth provided by the heating element. See for example, Sullivan et. al at col. 10, line 61--col.

Chang, col. 6, lines 6-13. Thus, the cited portion of Chang describes controlling "the degree of warmth provided by the heating element."

In contrast, Claim 2 of the present application recites:

2. (Currently Amended) A method for protecting data entry to a data entry device from eavesdropping, wherein a signature of data entry comprises a temperature differential in the data entry device from data entry by the user, comprising:

masking the signature of data entry resulting from entry of data by a user of the data entry device so as to reduce the detectability of the signature through eavesdropping **by controlling the external temperature of the data entry device to reduce temperature differentials left in the data entry device by the user.**

Claim 23 recites as follows:

23. (Currently Amended) A system for protecting data entry to a data entry device from eavesdropping comprising:
a data entry device, and

means for establishing the external temperature of the data entry device to reduce temperature differentials left in the data entry device by the user so as to mask a signature of entry resulting from entry of data by a user of the data entry device to reduce the detectability of a thermal signature by eavesdropping.

Applicants submit that the cited portion of Chang does not describe controlling or establishing the external temperature of the data entry device to reduce temperature differentials in the data entry device as recited in Claims 2 and 23. Chang only describes controlling the temperature of the heating element that is not in direct contact with the keys of the keyboard. Applicants submit that controlling the temperature of the heating element would not necessarily result in controlling the external temperature of the data entry device and, in particular, would not necessarily mask a signature of data entry. As

such, Applicants submit that the keyboard of Chang would not inherently control or establish the external temperature of the data entry device to mask a signature of data entry. Accordingly, Applicants submit that independent Claims 2 and 23, and the claims that depend from them, are neither disclosed nor suggested by Chang for at least these reasons.

V. The Claims Are Patentable Over Lipman

Claims 1, 14, 15, 19, 20, 21, 23, 33, 34 and 39 stand rejected under 35 U.S.C. § 102(e) (as stated in the Examiner's Answer, but under 102(b) in the Final Action) as anticipated by United States Patent No. 5,075,606 to Lipman (hereinafter "Lipman"). As discussed above, Claims 1 and 14 have been cancelled, Claim 15 has been written in independent form and Claim 23 has been amended to incorporate the recitations of Claim 25. Thus, Claim 23 as amended is not rejected based on Lipman. Claim 33 has been cancelled and Claim 34 has been written in independent form. Thus, Applicants will address the rejection of Claims 15 and 34. The Final Action cites to the previous Official Action, which rejects these claims based on col. 2, line 24 of Lipman.

Lipman is directed to a solid state DC fan motor. The cited portion of Lipman states that "[f]ans for computers and other electrical equipment are typically quite noisy due to the presence of torque/flutter, vibration, turbulence and acoustical noise." Lipman, col. 2, lines 24-26. Applicants submit that merely stating that fans of computers are noisy does not disclose or suggest the recitations of Claims 15 or 34. There is nothing in the cited portion of Lipman that discloses or suggests that the fan of Lipman is noisy and located in proximity of an input device such that any generated sound would mask a signature of data entry. Furthermore, even if noisy, unless the noise is at the correct frequency, such that it would mask data entry noises, the mere presence of noise would not necessarily nor reliably result in the masking recited in Claims 15 or 34. In fact, nothing in the cited portion of Lipman discloses or suggests masking data entry as recited in Claims 15 and 34. Applicants submit that, merely because something can be noisy, that does not disclose the recitations of the independent claims. Accordingly, Claims 15

and 34 and the claims that depend from them are neither disclosed nor suggested by the cited portions of Lipman for at least these reasons.

Applicants also note that Claim 21 is mentioned as anticipated by Lipman, however, these claims are not discussed in the anticipation rejections of the Final Action or the previous Official Action. See Final Action, p. 2. In particular, Claim 21 recites that, in addition to generating a masking sound, "the blower blows a stream of temperature-controlled air in proximity to the data entry device controlling the external temperature of the data entry device to reduce temperature differentials left in the data entry device by the user." Applicants submit that the recitations of Claim 21 are not disclosed or suggested by the DC fan of Lipman and, therefore, are separately patentable over Lipman for at least these reasons.

VI. The Claims Are Patentable Over Patrick

The Examiner's Answer withdrew the rejection of Claims 1, 14, 15, 16, 22, 23, 34, 35 and 36 under 35 U.S.C. § 102(b) that were previously stated to be anticipated by United States Patent No. 5,778,081 to Patrick (hereinafter "Patrick") as the Group III claims. As discussed above, Claims 1 and 14 have been cancelled, Claim 15 has been written in independent form and Claim 23 has been amended to incorporate the recitations of Claim 25. Claim 22 has been written in independent form. Thus, Applicants submit the amendments provide additional patentability.

VII. The Claims Are Patentable Over McGregor in view of Clausen

The Examiner's Answer rejects Claims 1, 14, 15-17, 22, 23, 34-37, 36 and 37 on a new ground of rejection at p. 4 of the Examiner's Answer. However, the Group 4 claims on page 3 of the Examiner's Answer (and the Final Action) does not include Claims 16, 22 and 35. See also page 11 where the bold title under Group IV includes Claims 16, 22 and 35 and the adjacent italicized line does not include these three claims. Applicants are unsure as to whether the Examiner meant to include Claim 16, 22 and 35 in the Group IV claims under this rejection and request clarification on this issue.

The above-noted claims stand rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 4,052,720 to McGregor (hereinafter "McGregor") in view of U.S. Patent No. 5,611,608 to Clausen ("Clausen"). As discussed above, Claims 1 and 14 have been cancelled, Claim 15 has been written in independent form and Claim 23 has been amended to incorporate the recitations of Claim 25. Claim 22 has been written in independent form. Thus, amended Claim 23 is not rejected based on McGregor and Clausen. Claim 33 has been cancelled and Claim 34 has been written in independent form. Thus, Applicants will address the rejection of independent Claims 15, 34 and 22.

The cited portion of McGregor describes noise control that combines a generated noise and music. Nothing in the cited portion of McGregor discloses or suggests that such generated noise and music be used to mask a signature of data entry as recited in Claims 15 and 34. Accordingly, Applicants submit that McGregor does not disclose or suggest the recitations of Claims 15 and 34 or the claims that depend from them for at least these reasons and analogous reasons to those discussed above with reference to Patrick.

Clausen fails to remedy the noted deficiencies. Applicants concede that the use of computers in offices is well known. However, patentability is not destroyed because separate elements exist in separate references. It is the claimed combination of features that is the proper focus of a patentability analysis. *Panduit Corporation v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1574 (Fed. Cir. 1987). Applicants submit that one of skill in the art would not have combined the cited references in a manner that would yield the claimed invention and that, even combined, McGregor and Clausen fail to teach or suggest the claimed subject matter.

Claim 22 recites "masking the signature of data entry resulting from entry of data by a user of the data entry device so as to reduce the detectability of the signature by eavesdropping by providing a sound-dampening device on the data entry device." The previously cited portion of McGregor does not describe a data entry device and, therefore, does not disclose or suggest a sound-dampening device on a data entry device. Accordingly, Applicants submit that McGregor does not disclose or suggest the recitations of Claim 22 for at least these reasons.

The Dependent Claims are Separately Patentable

While each of the dependent claims are patentable as depending from a patentable base claim, Applicants also submit that certain of the dependent claims are separately patentable over the cited references. For example, Claim 7 recites "monitoring the external temperature of the data entry device to provide a device temperature" and "adjusting the output of a temperature control mechanism responsive to the device temperature so as to maintain the device temperature at approximately the setpoint." Applicants submit that Chang does not disclose or suggest monitoring the external temperature of the device and adjusting a temperature control mechanism to maintain the device temperature. Similar recitations are found in Claim 32. Applicants submit that Claims 7 and 32 are separately patentable for at least these additional reasons.

Claim 39 recites that "the sound generator comprises a blower which disrupts the sound waves by blowing a stream of air in proximity to the data entry device." Applicants submit that the DC fan of Lipman does not disclose or suggest a blower that disrupts sound waves as is recited in Claim 39. As such, Applicants submit that Claim 39 is separately patentable for at least these additional reasons.

VIII. The Section 103 Rejections

Claim 8 stands rejected under 35 U.S.C. § 103 as obvious in light of Chang. Applicants submit that Claim 8 is patentable at least per its base claim. Furthermore, as Chang does not relate to masking a signature of data entry, Applicants submit that there would be no reason to modify Chang to perform such a function. Furthermore, Chang does not provide a range of operation but describes 120 °F as a maximum temperature. There is no indication in Chang that the recited range of Claim 8 should be used or that Chang controls the temperature of external surfaces to be within the range recited in Claim 8.

Claims 6, 13 and 29 stand rejected under 35 U.S.C. § 103 as obvious in light of Chang and United States Patent No. 4,727,655 to Jacobi Jr. (hereinafter "Jacobi"). Applicants submit that Claims 6, 13 and 29 are patentable as depending from a patentable

base claim. Applicants further submit that, as Chang does not relate to masking data entry, there would be no reason or motivation to modify Chang to perform such a function. Additionally, Jacobi describes a dryer for printed materials. See Jacobi, col. 2, lines 30-32. Applicants submit that, absent the teachings of the instant invention, one of skill in the art would not look to the heat lamp assembly of Jacobi that is used for drying coated printed materials to combine with the keyboard of Chang to result in the recitations of Claims 6, 13 or 29. Accordingly, Applicants submit that Claims 6, 13 and 29 are separately patentable over the cited references for at least these additional reasons.

Claim 21 stands rejected under 35 U.S.C. § 103 as obvious in light of Chang and Lipman. Applicant submits that Claim 21 is patentable at least per the patentability of its base claim. Applicants further submit that the combination of Chang and Lipman does not result in the recitations of Claim 21 and can only be arrived at through the impermissible use of hindsight. In particular, the combination of Chang and Lipman would provide a computer with a heated keyboard and a noisy fan. That is not what is claimed in Claim 21. Furthermore, as discussed above, neither Chang nor Lipman relate to masking of data entry. Thus, neither Lipman nor Chang are directed to solving the problem solved by the present invention. Accordingly, one of skill in the art would not be motivated to combine the unrelated teachings of Lipman with those of Chang to result in the recitations of Claim 21. Applicants, therefore, submit that Claim 21 is separately patentable for at least these additional reasons.

IX. Other Statements in The Examiner's Answer

The Examiner states in the Examiner's Answer that certain of the argued features were not claimed (*see*, "the applicant does not claim eavesdropping" p. 6, p. 10, p. 11, or a "feedback control" p. 6, or a complete masking of data entry sounds" p.10, Examiner's Answer). Applicants submit that the amendments above incorporate these features.

The Examiner's Answer has several claim rejection inconsistencies. For example, the Examiner's Answer states that the Group II claims, Claims 1, 14, 15, 19, 20, 21, 23, 33, 34, and 39 are now rejected under **102(e)** when they had been rejected under **102(b)**

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in the Final Office Action (albeit both rejections were based on U.S. Patent No. 5,075,606 to Lipman).

The Examiner's Answer also treats Claims 16 and 35 inconsistently as being in Group IV (p. 4) and not being in Group IV (p. 3). The Examiner's Answer also inconsistently modified the Group VI claims to add Claims 6 and 29 (when previously Group VI only included Claim 13) as stated on p. 5 and p. 14 in bold but did not include Claim 6 on p. 3 in the Group 6 listing. Accordingly, Applicants believe that each of the above actions raises a new ground of rejection.

X. Conclusion

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

It is not believed that an extension of time and/or additional fee(s) including fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

Respectfully submitted,



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